V. REMARKS

Claim 1 is provisionally rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claim 1 of co-pending Application No. 10/697,054. The rejection is respectfully traversed.

In determining double patenting, the issue is whether any claim of the application defines merely an obvious variation of an invention **claimed** in the earlier patent or application. It does not prohibit a later claiming of subject matter that is disclosed but not claimed in the earlier patent or application. Double patenting is concerned with attempts to "claim" related subject matter twice. In re Gibbs, 437 F.2d 486, 168 USPQ 578 (CCPA 1971). In other words, the issue in addressing the judicially created doctrine of obviousness-type double patenting is whether any claim of the application defines merely an obvious variation of the invention claimed in the earlier patent. It is respectfully submitted that the subject matter of claim 1 cannot be construed as an obvious variation of claim 1 in the co-pending application.

The Examiner must establish a *prima facie* case of obviousness-type double-patenting or the rejection, if applied, will be reversed by the Board of Patent Appeals. The Examiner is obligated to clearly set forth the basis of an obviousness-type double-patenting rejection. Under MPEP 804 II. B. 1., it states:

> Any obviousness-type double patenting rejection should make clear:
>
> (A) The differences between the inventions defined in the conflicting claims--a claim in the patent compared to a claim in the application; and
>
> (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

It is respectfully submitted that the rejection is improper because the Examiner fails to make clear the obviousness-type double patenting rejection, particularly subparagraphs (A) and (B) above. As a result, it is respectfully submitted that, United States Patent and Trademark Office fails to establish a *prima facie* case of obviousness-type double patenting.

Withdrawal of the rejection is respectfully requested.

The Office Action objects to the title of the invention. Applicant proposes changing the title to "GAMING MACHINE HAVING A VARIABLE DISPLAY" as indicated above.

Claims 1 and 6 are rejected under 35 USC 102 (b) as being anticipated by Ozaki (U.S. Patent Application Publication No. 2001/0031658). The rejection is respectfully traversed.

Ozaki teaches a pattern display device that includes a pattern display unit and a front side display unit. The pattern display unit has a display portion for displaying a plurality of different first patterns and is capable of performing a stationary display and a varying display. The front side display unit is disposed in front of the pattern display unit and capable of displaying a plurality of different second patterns overlapping with the plurality of first patterns. The front side display unit is transparent except for the plurality of second patterns.

Claim 1, as amended, is directed to a gaming machine that includes a game result display device for displaying a game result and a beneficial state generating device for generating a beneficial state for a player when a specific game result is displayed on the game result display device. Claim 1 recites that the game result display device includes a first display device and a second display device arranged at a more front side than a display area of the first display device when seen from a front side of the gaming machine. Additionally, claim 1 recites that the second display device defines a liquid crystal display area having an effect display area and a plurality of symbol display areas with the plurality of symbol display areas being

provided to selectively display the game result. Furthermore, claim 1 recites that the second display device is operative to display a specific image simultaneously on at least partially the effect display area and on at least partially one of the plurality of symbol display areas such that the liquid crystal display area prevents a user from seeing the game result in the plurality of symbol display areas or on at least partially the effect display area but not on any of the plurality of symbol display areas such that the liquid crystal display area permits the user to see the game result on the plurality of symbol display areas along with at least a portion of the specific image displayed only on the effect display area.

It is respectfully submitted that the rejection is improper because the applied art fails to teach each and every element of claim 1 as amended. Specifically, it is respectfully submitted that the applied art fails to teach that the second display device is operative to display a specific image simultaneously on at least partially the effect display area and on at least partially one of the plurality of symbol display areas such that the liquid crystal display area prevents a user from seeing the game result in the plurality of symbol display areas or on at least partially the effect display area but not on any of the plurality of symbol display areas such that the liquid crystal display area permits the user to see the game result on the plurality of symbol display areas along with at least a portion of the specific image displayed only on the effect display area. Thus, it is respectfully submitted that claim 1 is allowable over the applied art.

Claim 6 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Claims 2, 3 and 5 are rejected under 35 USC 103 (a) as being unpatentable over Ozaki in view of Loose (U.S. Patent Application Publication No. 2003/0130033). The rejection is respectfully traversed.

Loose teaches a method of generating display indicia on a gaming machine in synchronization with an adjacent gaming machine. The gaming machine includes a display, an emitter and a sensor. The method includes the steps of detecting a first signal from the adjacent machine at the sensor and, in response to the first signal, generating the display indicia on the display and emitting a second signal from the emitter.

Claims 2, 3 and 5 depend from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claims are allowable at least for the reason claim 1 is allowable as well as for the features they recite.

Withdrawal of the rejection is respectfully requested.

Claim 4 is rejected under 35 USC 103 (a) as being unpatentable over Ozaki in view of Loose and further in view of Glavich et al. (U.S. Patent Application Publication No. 2003/0064796). The rejection is respectfully traversed.

Glavich discloses a gaming device having a plurality of reels with each reel having a plurality of award symbols, a terminating condition, at least one award indicator and a processor connected to the reels. The processor activates the reels and randomly stops one of the reels. An award is provided to the player if an award symbol is indicated on the stopped reel. If a terminating condition occurs with respect to a reel, the reel is deactivated. If a terminating condition does not occur, the processor re-activates the reel. The gaming device continues to activate the reels until all of the reels are deactivated. The player then receives the total accumulated award for the bonus game.

Claim 4 depends from claim 1 and includes all of the features of claim 1. Thus, it is respectfully submitted that the dependent claim is allowable at least for the reason claim 1 is allowable as well as for the features it recites.

Withdrawal of the rejection is respectfully requested.

Newly-added claims 7-9 also include features not shown in the applied art.

Further, Applicants assert that there are also reasons other than those set forth above why the pending claims are patentable. Applicants hereby reserve the right to submit those other reasons and to argue for the patentability of claims not explicitly addressed herein in future papers.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' representative at the telephone number listed below.

Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same, the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: May 29, 2007

By: _____
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